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Appeal Brief
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCE'S**

In re application of: George S. Gabriel, *et al.*
Serial No: 09/173,134
Filed: October 15, 1998
For: MULTIPURPOSE RAT CAGE
Art Unit: 3643
Examiner: Son T. Nguyen
Attorney Docket Number: 364106/176



APPEAL BRIEF

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ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

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Sir:

This application is before the Honorable Board of Appeals on appeal from the Final Rejection issued by the Examiner dated October 26, 1999, wherein all the claims under consideration, claims 1-6, were finally rejected. A Notice of Appeal being timely filed on April 26, 2000.

Please charge the filing fee of \$310 to the attorney's Deposit Account No. 19-4709, in compliance with 37 CFR § 1.17(c). As required by 37 CFR § 1.192 this Brief is filed in triplicate. The petition for an extension of time is also attached, please charge the fee of \$1,390 for a four-month extension of time and any deficiencies to the attorney's Deposit Account No. 19-4709. Accordingly, this brief being timely filed.

REQUEST FOR ORAL HEARING

An oral hearing is requested. Please charge the fee of \$270 the and any deficiencies to undersigned attorney's Deposit Account No. 19-4709.

Certificate of Mailing (37 C.F.R. 1.8)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on (Date) October 17, 2000.

Typed or printed name of person signing this certificate:

Linda Granda-Solis

Signature: Linda Granda-Solis

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(1) REAL PARTY IN INTEREST

Lab Products, Inc.
742 Sussex Road
Seaford, DE 19973

This application has been assigned to Lab Products, Inc. by Assignment recorded at Reel 9730 Frame 0076.

(2) RELATED APPEALS AND INTERFERENCE'S

To the best of Applicant's knowledge there are no appeals or interference actions that will be affected by this appeal.

(3) STATUS OF CLAIMS

Claims 1-6 are pending in the application. Claims 1 through 6 remain in this case, and were amended by the response dated October 1, 1999.

(4) STATUS OF AMENDMENTS

The Examiner entered the amendments made in the Applicant's response dated October 1, 1999. No amendments have been filed subsequent to the Final Rejection issued by the Examiner.

(5) SUMMARY OF THE INVENTION

Claims 1-6 on appeal are directed to a multi-species cage level barrier cage used in conjunction with a ventilated cage and rack system having a unique footprint that within the constraints of federal guidelines, and the construction of conventional modern laboratories, optimizes the flexibility and efficiency of the caging solutions provided to researchers. This is accomplished with the ventilated rack system by

increasing animal density for certain species and by optimizing the footprint of the cage and the overall dimensions of the rack. The purpose of the caging system provided in the instant invention is to provide laboratory researchers and scientific institutions with a double-sided ventilated caging system including a cage-level barrier cage with a specific footprint such that it complies with appropriate federal guidelines while simultaneously being available to house a multiplicity of different animals typically used in scientific studies. This unexpected optimization of the cage footprint for a cage-level barrier cage system allows the researcher to maximize the number and type of respective animals which may be used in laboratory studies simultaneously. While in the caging system of the invention the user is also provided with improved mobility of the entire rack system. That is, the dimensions of the caging system are optimized within the rack to allow the rack to not only to most efficiently house a multiplicity of species, but to allow the mobility of the cage and rack system in the constraints of conventional laboratory structures such as doorways.

Moreover, the fact that the improved cage footprint allows multiple species to be housed in the same cage while staying within federal guidelines for the animal research field saves the scientist and the research institution significant financial resources that would otherwise be spent on purchasing and maintaining separate caging systems and racks for each of the animals typically used in scientific research.

Claim 1, the two independent claims on appeal, defines a multi-purpose cage level barrier rodent cage for housing multiply species of rodents, including a plurality of mice or rats in a ventilated rack and cage system, the cage comprising a cage bottom having a plurality of integral side walls, a floor and an open top end. The floor has a length and width such that the product of the length and width is greater than or equal to 80 square inches and less than or equal to 110 square inches. Claim 2 defines the preferred embodiment in which the length and width is substantially 80 square inches. Claim 3, the other independent claim on appeal defines a cage level barrier cage ventilated rack and cage system for housing a plurality of types of rodents including a plurality of mice or rats within a cage. This system includes a double-sided rack having a depth. At least one cage is disposed in the rack and the cage has a cage bottom, the

cage bottom having side walls, a floor and an open top. The length of the cage is less than substantially 18 inches.

Claim 4 defines that the cage bottom have a length and width such that the product of the length and width is greater than or equal to 80 square inches or less than or equal to 110 square inches.

Claim 5 defines that the rack have a depth and the cage rest within the rack such that the length of the cage partially overlaps the depth of the rack. A portion of the cage also extends beyond the rack, the portion which extends beyond the rack have a length and the sum of the length of the portion and the depth of the rack combined is less than or equal to substantially 36 inches.

Claim 6 requires that the length of the cage be substantially less than 36 inches.

References Relied Upon or Made of Record by the Examiner

- a) Lovitt *et al.*, United States Patent No.# 3,978,819 for " CAGE AND ACCESSORIES THEREFOR."

References Made of Record or Documents Relied Upon by the Applicants

- a) Lovitt *et al.*, United States Patent No.# 3,978,819 for "CAGE AND ACCESSORIES THEREFOR;"
- b) Coiro *et al.*, United States Patent No. # 5,894,816 for "CAGE FOR HOUSING ANIMALS AND METHOD FOR ENHANCING FLOOR SPACE OF SAME;"
- c) ANIMAL WELFARE ACT 9 C.F.R. §§ Chapter 1 et seq. (1966); and as amended 7 U.S.C. §§ 2131 *et seq.*; and

- d) GUIDE FOR THE CARE AND USE OF LABORATORY ANIMALS, Institute of Laboratory Animal Resources (ILAR);National Academy Press Washington, D.C. (1996).

Case Law Made of Record, Or Relied Upon by Applicants

- a) *United States v. Adams*, 383 U.S. 39 (1966).
- b) *Graham v. John Deere Company*, 383 U.S. 1, (1966).
- c) *In re Rijckaert*, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993).
- d) *In re Bell*, 991 F.2d. 781, 26 U.S.P.Q. 1529 (Fed. Cir. 1993).
- e) *Wang Laboratories, Inc. v. Toshiba Corp.* 26 U.S.P.Q. 2d 1767 (Fed. Cir. 1993)
- f) *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992)
- g) *In re Clay*, 23 U.S.P.Q. 2d 1058 (Fed. Cir. 1992)
- h) *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).
- i) *King Instrument Corp. v. Otari Corp.*, 226 U.S.P.Q. 402 (Fed. Cir. 1985)
- j) *Union Carbide Corp. v. American Can Co.*, 220 U.S.P.Q. 584 (Fed. Cir. 1984).
- k) *W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)
- l) *In re Pardo*, 214 U.S.P.Q. 673 (C.C.P.A. 1982)
- m) *In re Wilder*, 429 F.2d 447, 166 U.S.P.Q. 545 at 548 (C.C.P.A. 1970).
- n) *In re Chevenard*, 139 F.2d 71, 60 U.S.P.Q. 239 (C.C.P.A. 1943)

(6) ISSUE

The Board must decide:

- I. Whether claims 1-6 are allowable under 35 U.S.C. §103(a) in view of Lovitt *et al.*, United States Patent No.# 3,978,819 entitled, "CAGE AND ACCESSORIES THEREFOR?"

(7) GROUPING OF CLAIMS

For purposes of this appeal, the claims 1-6 are not argued separately, and stand or fall together.

(8) ARGUMENT

With Respect to Issue I

Claims 1-6 were rejected under 35 U.S.C. §103(a) in view of Lovitt *et al.*, United States Patent No.# 3,978,819 (hereinafter the '819 patent). This rejection is, respectfully, improper, and should be reversed.

Argument

**I. THE CLAIMS ON APPEAL ARE NOT OBVIOUS UNDER THE FACTUAL INQUIRIES
REQUIRED BY *GRAHAM V. JOHN DEERE COMPANY***

The Final Rejection rejects claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over the prior art disclosed in the specification in view of Lovitt *et al.* However, an analysis under the three-part test of *Graham v. John Deere Company*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966),

leads to the conclusion that the claims on appeal are not obvious over the prior art reference.

Graham sets forth, the factual inquiries necessary to determine obviousness. These are as follows:

1. The scope and content of the prior art are to be determined;
2. The differences between the prior art and the claims at issue are to be ascertained;
and
3. The level of ordinary skill in the pertinent art is to be resolved.

Graham directs that it is against this background that the obviousness issue is determined.

A. LOVITT *ET AL.* IS NOT AN APPROPRIATE REFERENCE AND DOES NOT FALL WITHIN THE SCOPE OF THE APPLICABLE PRIOR ART.

The Examiner argued in the Office Action that the claimed invention is a mere design choice to one having ordinary skill in the art. However, this ignores the activities of those skilled in the art at the time of this invention, and is contrary to the level of skill present in the art. The Examiner concedes that Lovitt does not disclose and is in fact silent with regard to the dimensions of the cage. Rather, the Examiner argues, "to dimension the cage bottom and the rack of Lovitt with various lengths, widths and depths in order to accommodate the different sizes that contain animal and different housing entrances where the rack is to be stored [is conventional]." Curiously, the solution suggested by the Examiner captures the prior art and the disadvantages thereof; namely differently sized racks and variously sized cages to accommodate variously sized animals. It was not until the invention of the Applicants that a single cage and rack was capable of housing multiple species and animals with a single-sized cage.

With the development of cage level barrier cages, such that the entire protective environment, i.e. the cage itself, needed to be situated on racks that needed to be housed in dedicated facilities. Building planners, protocol designers, the doctors in charge of studies, and cage designers became very aware that floor space within a cage was at a premium. More than

30 years ago, the Federal Government enacted guidelines determining the minimum floor space that would be acceptable for different species and sizes of rodents in sanctioned animal studies. With this background, the industry, those skilled in the art, typically provided cages having floor areas of 134 inches or more to house one large rodent such as rats, hamsters or guinea pigs. On the other hand, smaller rodents such as mice, were housed in smaller cages having areas of 75 square inches or less. The common practice of those skilled in the art in the industry prior to Applicants' breakthrough invention was that through a multiplicity of cage sizes the shelf-space within racks and in research facilities would be maximized.

The Examiner's analysis thus inappropriately bases its rejection on the premise that one caging system for laboratory animals is like another, and that therefore any animal caging system is an appropriate analogous prior art reference for the claimed invention of another such caging system. However, as the Federal Circuit recently stated, "[t]wo criteria are relevant in determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the art is not within the same field of endeavor, whether it is still reasonably pertinent to a particular problem to be solved," *Wang Laboratories, Inc. v. Toshiba Corp.* 26 U.S.P.Q. 2d 1767, 1773 (Fed. Cir. 1993); *see also, In re Clay*, 23 U.S.P.Q. 2d 1058, 1060 (Fed. Cir. 1992); (The *Wang* court found that a prior art reference for using a nine bit controller consisting of nine memory chips encapsulated in ceramic dual in-line packages mounted on a circuit board substrate is not in the same field of endeavor as the claimed nine data memory chips for storing digital data on epoxy glass printed circuit board substrate merely because it relates to memories). *Id.* The Court further let stand a lower Court finding that the prior art reference was not analogous art and was not reasonably pertinent, i.e. the art would not logically have commended itself to an inventor's attention in considering his problem. *Wang* at 1773, and *Clay* at 1061. The relevance of the *Wang* analysis to the instant matter lies in the fact that the Lovitt reference is not only silent with regard to cage dimension and/or adherence to Federal Guidelines with regard to appropriate caging for laboratory animals but rather focuses on automating waste removal and applying disinfectant through the use of a consistently moving belt beneath animal cages, an entirely different problem, with an entirely different set of concerns and hurdles preventing success. (See Lovitt *et al.*, columns 9-12, the claims). Thus, though Lovitt might contemplate the caging of mice, the problem addressed and the solution provided therefore

have little or nothing to do with the caging problem overcome by the instant claims, therefore falling outside the scope of appropriate art.

In a similar situation, the Federal Circuit concluded that as between a method and apparatus in which film is transferred to a welding station and a tape splicing machine capable of handling the same film, "the light of all this evidence, one can reasonably conclude that the reference is not within the field of this inventor's endeavor and was not directly pertinent to a particular problem with which the inventor was involved." *King Instrument Corp. v. Otari Corp.*, 226 U.S.P.Q. 402, 405 (Fed. Cir. 1985); *see also, Union Carbide Corp. v. American Can Co.*, 220 U.S.P.Q. 584, 588 (Fed. Cir. 1984).

As in the *King* and *Wang* situations, the instant claimed invention is directed to features, methods and solutions of problems which are alien and non-analogous to the prior art cited by the Examiner. Therefore the teachings of Lovitt *et al.*, are not pertinent to the claimed invention. For example, columns 4-5 of the Lovitt *et al.* reference teach providing a "wash pan 57" and a "belt member 61" for cleaning an endlessly moving belt so as to remove waste from a series of rodent cages. The moving belt member is sequentially scraped of waste, washed with water, and then disinfected. *See*, column 4-6, Lovitt *et al.* This is because the object of Lovitt *et al.*, as described in its Abstract is to provide an improved rodent cage that "facilitates maintenance and care and is adapted for use in a battery." Abstract, lines 2-3. This is an explicit recognition, on the part of the reference itself, that the reference's teachings are limited to the cleanliness of a rodent caging system and are not automatically transferable to caging solutions designed to overcome other problems such as optimizing the footprint of a multi-species barrier level caging system while accommodating applicable federal rules and guidelines.

Accordingly, as in *Wang* and *King*, one must conclude that Lovitt *et al.* is not within the field of this inventor's endeavor and is not pertinent in any way to the particular problems solved by the invention claimed in claims 1-6. Applicants therefore respectfully request the withdrawal of the rejection of claims 1-6 under 35 U.S.C. §103(a).

B. EVEN IF LOVITT *ET AL.* IS ANALOGOUS ART, LOVITT *ET AL.* TEACHES AWAY FROM THE
CLAIMED INVENTION

The claimed invention of claims 1-6 is an animal caging system that optimizes the volume and footprint of laboratory animal caging while remaining compliant with existing federal regulations regarding caging systems. With regard to the Lovitt *et al.*, reference the Examiner considers it as a reference that discloses an animal caging system analogous to that claimed in the instant invention. (Office Action of 10/26/99; page 2 numbered paragraph 3). As discussed above, the caging system of the current claims focuses on optimizing the footprint of cages compliant with Federal regulations while Lovitt *et al.*, focuses on improving sanitary conditions through automated waste removal and automated cleaning of the waste removing "belt member." As stated previously, the Lovitt *et al.*, reference is completely silent regarding the cage dimensions and any consideration of the hurdles overcome by the Applicants. The Examiner argues that it would have been an obvious "matter of choice" to one skilled in the art to change the dimensions of the cage to fall within the range of a footprint having an area between 80 square inches and now 110 square inches, but Lovitt does not provide a basis for supporting this argument and in fact teaches solutions to problems not considered or pertinent to those present in the instant invention.

As discussed during the Examiner interview, claims 1 and 3, as presently amended, are directed to a multipurpose cage level barrier rodent cage for housing multiple species of rodents including a plurality of mice or rats in a ventilated rack and cage system. Furthermore, the size of the cage has a floor area between 80 square inches and 110 square inches. As discussed, there are two significant factors. First, that the cage involved is a cage level barrier cage, a component part, for use in a ventilated rack and cage system and that the footprint (floor area) falls within a range of 80 square inches to 110 square inches which maximizes the efficiency of the use of space for housing a plurality of species of animals, most particularly, a plurality of mice and rats.

As discussed during an interview with the Examiner, a significant development in determining how those skilled in the art viewed cage sizing was the advent of cage level barrier cages as pioneered by the assignee of this application Lab Products, Inc. Because the cage now became the entire protective environment, the cages needed to be situated on racks, that needed to

be housed in dedicated facilities. With this background, Lovitt *et al.*, provides no guidance, while the industry, and those skilled in the art, adopted different standards.

As shown by the issuance of the most recent patent to Michael Coiro, U.S. Patent No. 5,894,816, assigned to Allentown Caging, rather than change the floor space or optimize the overall footprint, the approach utilized was to maximize floor space specifically for mice. This was done not by increasing floor space, but by changing the draft of the angle between the floor and the walls of the cage and measuring the floor space at a height above the cage floor to obtain a more efficient 75 inch floor space. The Coiro cage is therefore not a cage which provides a more efficient overall floor space for mice and other species.

Therefore, the relied upon prior art is deficient in two ways. First, it is not a cage level barrier cage system. Thus, it fails to teach the special environment for which this invention is designed; namely an environment in which the entire environment is controlled by the cage size, materials, food and water supplying mechanisms and the like for this special environment. Secondly, as conceded in the Office Action, the prior art is silent as to the actual dimensions of the cage, and it is error to find an invention obvious where the prior art reference diverges from and fails to teach or mention the invention at hand. *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1549-50 (Fed. Cir. 1983). Moreover, as demonstrated by the level of skill in the art as shown by the recently issued Coiro patent, no one in the industry other than the Applicants has approached the problem of marrying the requirements for all rodent species of interest to provide a common housing which maximizes the efficiency of the "real estate" available in the cage, rack and lab environment. The novelty present in the current invention was taking cage design in an entirely different direction than that performed and suggested by those skilled in the art, to arrive at a cage level barrier cage having a true floor area between 80 and 110 inches and to maximize the efficiency and use of a cage for housing rodents including a plurality of mice and a plurality of rats with a single type of cage. This is not mere design choice, but the result of recognizing a problem, and inventing a solution.

It was argued by the Examiners at the interview that a 75 inch or less cage could, in fact, house two rats, although uncomfortably. Therefore, it was considered that the prior art such as the Coiro cage incidentally anticipated the claimed invention. However, a reference cannot incidentally teach the invention if such a use is impermissible. The Federal guidelines specifically

teach that a plurality of rats, a hamster or a guinea pig cannot be housed in a cage having less than the claimed 80 square inches. Therefore, the Federal government will not sanction any studies having a plurality of rats housed in a cage sized for mice. Therefore, in effect, no one skilled in the art would look in that direction to design a multispecies rodent cage and this is an additional reason why the Lovitt et al., reference is inappropriately cited as a reference. More to the point, the cited reference must disclose to the public an available way of making the product or achieving the result *successfully*, within the constraints of the technically possible and that allowable by law or regulation, if it is to properly remain grounds for a rejection based on obviousness. As the United States Supreme Court has stated, "An inoperable invention or one which fails to achieve its intended result does not negative novelty." *United States v. Adams*, 383 U.S. 39 at 49-51 (1966). For this reason, failed experiments or inoperative inventions **cannot be considered prior art** sufficient to support an Examiner's rejection, be it one based on anticipation or obviousness. *In re Wilder*, 429 F.2d 447, 166 U.S.P.Q. 545 at 548 (C.C.P.A. 1970).

Accordingly, not only is there a difference between the prior art relied upon by the Examiner and the claimed invention, the prior art including both Coiro *et al.*, and Lovitt *et al.*, such that the cited prior art either teaches away from the current invention or teaches a method or structure for altering an intended and realistic result in the current invention, and in so doing both references are ineligible to support an obviousness rejection. Applicants therefore respectfully request the withdrawal of the rejection of claims 1-6 under 35 U.S.C. §103(a).

C. APPELLANT RECOGNIZES THAT THE LEVEL OF ORDINARY SKILLED IN THE ART IS HIGH

Applicant recognizes that the level of ordinary skill in the art is high. This is supported by the requirement of an understanding of the effects of animal caging solutions on existing rack systems, accommodation of existing regulations concerning minimum space for individual species of laboratory animals, the concern for both the environmental enrichment of laboratory animals and their hygiene, as well as the dearth of references uncovered by the Examiner. However, in light of the above, even given the relatively high standard of skill in the art, the clear lack of any teaching in any analogous art of applying solutions for animal caging systems requires a resolution

of the *Graham* test with a finding of non-obviousness of the claims on appeal. Applicants therefore respectfully request the withdrawal of the rejection of claims 1-6 under 35 U.S.C. §103(a).

II. SECONDARY CONSIDERATIONS INCLUDING LONG FELT NEED

A showing that an invention has satisfied a long felt need for a problem is relevant evidence of the non-obviousness and patentability of an invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1054-55 (Fed. Cir. 1988). To that end, it is important to note that the Applicants developed a caging system that not only optimized the footprint of an animal cage for purposes of a mobile rack system containing a plurality of animal cages, they did so while staying within the constraints of federal guidelines promulgated to protect laboratory animals. As discussed above, the Animal Welfare Act ("AWA") (enacted in 1966) and the Institute of Laboratory Animal Resources ("ILAR") Guidelines (1996) specify certain space parameters for specific animal species and for animals at specific developmental stages or weights. ANIMAL WELFARE ACT 9 C.F.R. §§ Chapter 1 et seq. (1966), *and as amended* 7 U.S.C. §§ 2131 et seq.; *and see*, GUIDE FOR THE CARE AND USE OF LABORATORY ANIMALS, Institute of Laboratory Animal Resources (ILAR); National Academy Press Washington, D.C. (1996).

The purpose of these rules was to mandate a minimum level of space for each species of laboratory animal so as provide them with a hygienic and humane environment. However, as discussed above the practical effect was that those skilled in the art began to produce a multiplicity of cages, each of a different size, one caging solution to fit each laboratory animal. This can be seen in the prior art as exemplified by the Coiro patent cited above where competitors in the relevant field are relying on a multiplicity of cage designs for different animals. In this multiplicity of caging solutions the instant inventors developed the concept of a cage suitable for housing a variety of laboratory animal species, while their competitors failed to do so. It should therefore be apparent that while the Coiro *et al.*, reference epitomizes the industry answer to the AWA and ILAR mandates, the instant invention provides an elegant

answer that helps institutional researchers by reducing overall costs necessary to study a variety of animals over time (e.g., by eliminating the need to purchase multiple cage sizes and rack sizes). In addition, though the Lovitt information may be interesting for those involved in automating the removal of wastes from a laboratory animal's cage, this reference *has little to do with the development of a caging system capable of holding multiple species of laboratory animals within federal guidelines*, and thus cannot be considered to make "obvious" the Applicant's discovery.

Given the above, Applicant's have demonstrated a long felt need in the industry for the caging system that is the focus of the current claims. This showing provides another indicia of the non-obviousness and patentability of the current claims. Applicant therefore respectfully suggests that claims 1-6 cannot be obvious over the reference cited.

III. THE EXAMINER FAILS TO MAKE OUT A CASE OF *PRIMA FACIE* OBVIOUSNESS

Establishment of a *prima facie* case of obviousness is a procedural tool for allocating the burden of proof as between an Applicant and the Examiner. The initial burden is upon the Examiner to present this *prima facie* case of obviousness to negative patentability. In the current case the Examiner failed to establish the needed case of obviousness, thus without more the Applicant is entitled to a grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A *prima facie* case of obviousness is established when the teachings from the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 26 U.S.P.Q. 1529 (Fed. Cir. 1993); *In re Rijckaert*, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). The basic considerations which apply to obviousness rejections under MPEP § 2141 are as follows:

- (1) the claimed invention must be considered as a whole;
- (2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

- (3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (4) reasonable expectation of success is the standard by which obviousness is determined.

When the prior art itself fails to meet even one of the above criteria the cited art does not satisfy 35 U.S.C. § 103(a) and prevents the establishment of the required *prima facie* case of obviousness by the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). As pointed out above, the '819 patent not only fails to render obvious the current claims it also fails to provide any incentive to combine with other prior art.

Moreover, if these failings are insufficient to disqualify the Lovitt reference as capable of rendering the instant claims obvious it should be noted that if the prior art methodology must be modified in any way to practice the instant invention the prior art citation must also render obvious these modifications or provide a reasonable expectation for the successful practice of the invention with the necessary modifications within the four corners of the reference itself, in this case the '819 patent fails to provide any suggestion of modifying a cage level barrier rodent cage footprint to accommodate multiple animal species in a rack and ventilation system. *In re Oetiker*, at 1446. In fact, the Examiner admits that the prior art including Lovitt *et al.*, fails when she states that Lovitt "does not disclose a sum of the length of a portion [of the caging system] extending beyond the rack and a depth of the rack..." (Office Action 10/26/99, page 3, 1st paragraph). With this failure, the Lovitt reference also fails to support any case of *prima facie* obviousness.

The Examiner then goes on to assert that, "discovering the optimum or workable ranges involves only routine skill in the art.." (Office Action 10/26/99, page 3, 1st paragraph). The difficulties associated with developing the instant invention, the long felt need for the invention and the answer of others in the industry is discussed above, but important here is that the *prima facie* case that the Examiner must provide is one of factual, objective evidence. Respectfully, if the Examiner seeks to introduce as fact a personal opinion, the appropriate means is through the completion of an affidavit or declaration, short of this, speculative comments or bare assertions

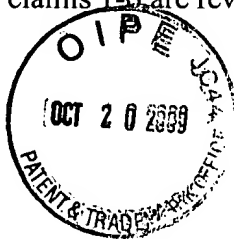
are improper grounds for maintaining a rejection. *In re Pardo*, 214 U.S.P.Q. 673, 677 (C.C.P.A. 1982); *In re Chevenard*, 139 F.2d 71, 60 U.S.P.Q. 239 (C.C.P.A. 1943); (Appellant reserves the right to challenge any objective evidence presented by the Examiner); 37 C.F.R. § 1.107. Barring such an affirmative assertion the analysis already provided is sufficient to defeat any obviousness rejection.

Given the above, no *prima facie* case of obviousness can be made out based on the Lovitt *et al.*, reference. Therefore, any rejections of claims 1-6 at issue here under § 103(a) should be reversed, and such is respectfully requested.

Conclusion

Appellant respectfully submits that Lovitt *et al.* does not make obvious the claims on appeal and that rejection under 35 U.S.C. § 103(a) is therefore improper. Specifically, Lovitt *et al.*, because it focuses on cleaning cages rather than optimizing their size and shape for multiple species, current rack and ventilation systems, and in compliance with ILAR and AWA, is not analogous art, and even if analogous art, is silent as to any teaching or even suggestion of creating a cage level barrier or optimizing the cage footprint to produce better caging system for laboratory animals. The lack of any such teaching in the reference to suggest the claimed invention therefore requires reversal of the Final Rejection of the Examiner.

Based upon the arguments made herein, the applicant requests that the Examiner's rejections of claims 1-6 are reversed, and those said claims be allowed to go to issue.



Respectfully submitted,

Dated: October 17, 2000

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**APPENDIX
BOARD OF PATENT APPEALS AND INTERFERENCE'S
APPEAL BRIEF**

In Re application of: George S. Gabriel, *et al.*
Serial No: 09/173,134
Filed: October 15, 1998
For: MULTIPURPOSE RAT CAGE
Art Unit: 3643
Examiner: Son T. Nguyen
Attorney Docket Number: 364106/176

The Claims On Appeal

1. A multipurpose cage level barrier rodent cage for housing multiple species of rodents, including a plurality of mice or rats in a ventilated rack and cage system, the cage comprising a cage bottom having a plurality of integral side walls, a floor and an open top end, said floor having a length l and a width w wherein
$$80 \text{ square inches} \leq l \times w \leq 110 \text{ square inches}$$
2. The multipurpose rat cage of claim 1, wherein $l \times w$ is substantially 80 square inches.
3. A cage level barrier cage ventilated rack and cage system for housing a plurality of types of rodents including a plurality of mice or rats within a cage, the system comprising a double sided rack, the rack having a depth;

at least one cage disposed in said rack, said cage having a cage bottom, the cage bottom having a plurality of integral side walls, a floor and an open top, and the length of the cage being less than substantially a 18 inches.

4. The system of claim 3, wherein said cage bottom has a length l and a width w , wherein

$$80 \text{ square inches} \leq l \times w \leq 110 \text{ square inches}$$

5. The system of claim 3, wherein the rack has a depth and the cage rests within said rack so that said length of said cage at least partially overlaps said depth of said rack and a portion of said cage extends beyond said rack, the portion having a length and the sum of the length of the portion and the depth of said rack is less than or equal to substantially 36 inches.

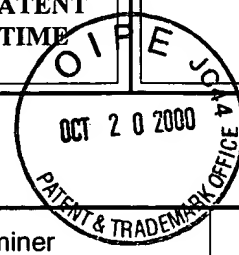
6. The system of claim 3, wherein said length l of said cage is less than substantially 36 inches.

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COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Large Entity)

Docket No.
364106/0176

In Re Application Of: George S. Gabriel et al.



Serial No.
09/173,134

Filing Date
October 15, 1998

Examiner
Son T. Nguyen

Group Art Unit
3643

Invention:

MULTIPURPOSE RAT CAGE

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TO THE ASSISTANT COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

☐ One month ☐ Two months ☐ Three months ☒ Four months ☐ Five months

from: June 26, 2000 until: October 26, 2000
Date Date

The fee for the Appeal Brief and Extension of Time has been calculated as shown below:

Fee for Appeal Brief: \$310.00

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TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$1,700.00

The fee for the Appeal Brief and extension of time is to be paid as follows:

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☒ Any patent application processing fees under 37 CFR 1.17.

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This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:

Byron V. Pokotilow Reg. No. 42,960 Dated: October 17, 2000
Signature

For
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